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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,082	03/10/2004	Mireille Maubru	05725.1274-00	2687
22852	7590	07/02/2008	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1615	
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			07/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/796,082	<b>Applicant(s)</b> MAUBRU ET AL.
	<b>Examiner</b> JYOTHSNA A. VENKAT	<b>Art Unit</b> 1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 March 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4,5,7-9,27,32,36,37,51,53,55,57,60-62,64,66 and 73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4-5,7-9,27,32,36-37,51,53,55,57,60-62,64,66, and 73 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No./Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No./Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

Receipt is acknowledged of remarks and letter regarding the submission of certified English language translation of provisional application. Applicants' submitted English language translation of provisional application, which is placed in the file wrapper of provisional application.

Applicants are notified that claims 32 and 37 are pending in the application since the elected species is present in these claims. Claims 1, 2, 4-5, 7-9, 27, 32,36-37, 51, 53, 55, 57, 60-62, 64, 66, and 73 are pending in the application and the status of the application is as follows:

##### ***Claim Rejections - 35 USC § 103***

Claims 1, 2, 4-5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 are rejected under 35 U.S.C. 103(a) as being obvious over **commonly owned U. S. Patent 7,258,852 ('852) or US 2003/0108503('503) or US 2003/0103927('927) or US 2004/0001796('796) or US 2003/0103929('929)** all taken individually and combined with **US 2004/0197356('356) or US 2004/0197355('355).**

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the

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application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C.

103(a). See MPEP § 706.02(l) (1) and § 706.02(l) (2).

*The instant application is claiming a cosmetic composition comprising:*

*1. At least one cross-linked copolymer comprising at least one methacrylic acid unit and at least one C1-C4 alkyl acrylate unit,*

*2. Polyethyleneimine, and*

*3. Particles comprising at least 10% by weight of calcium carbonate*

*4. Silicone (claims 57, 60 and 62)*

*5. One agent beneficial to keratin material (claims 61 and 64)*

*6. Surfactant (claim 66)*

Patent '852 teaches cosmetic compositions containing a methacrylic acid copolymer, which is ingredient 1 at col.2, line 5 to col.3m line 8 and teaches cationic and amphoteric polymers at col.3, line 60 to col.10, line 5 and see col.10, line 2 for ingredient 2, see col.15, ll 5-10 for the weight percent of ingrdient2, see col.15, line 11 to col.19, line 51 for ingredient 6, and see col.19, line 58 for ingredient 4 and see the same column ll 53-61 for ingredient 5 and see col.21, ll 50-65 for application to keratin materials.

PGPUB ('503) teaches cosmetic compositions comprising ingredient 1, 2 and 4-6. see the title, see the abstract, see paragraphs 20-32 for ingredient 1, see paragraphs 36-79 for ingredient 4, see paragraphs 80-151 for the cationic polymer and see paragraph 151 for the elected species

belonging to cationic polymer, which is ingredient 2, see paragraphs 245-315 for ingredient 6 and see paragraph 317 for ingredient 5 and see paragraphs 323-324 for various applications and see also paragraphs 336-339 for application of the compositions to keratin material.

PGPUB ('927) teaches cosmetic compositions comprising ingredient 1, 2 and 4-6. see the title, see the abstract, see paragraphs 16-27 for ingredient 1, see paragraphs 28-37 for ingredient 4, see paragraphs 38-107 for the cationic polymer and see paragraph 108 for the elected species belonging to cationic polymer, which is ingredient 2, see paragraphs 193-270 for ingredient 6 and see paragraph 271 for ingredient 5 and see paragraphs 290-293 for application of the compositions to keratin material.

PGPUB ('796) teaches cosmetic compositions comprising ingredient 1, 2 and 4-6. see the title, see the abstract, see paragraphs 14-29 for ingredient 1, see paragraphs 51-60 for ingredient 4, see paragraphs 63-129 for the cationic polymer and see paragraph 130 for the elected species belonging to cationic polymer, which is ingredient 2, see paragraphs 187-258 for ingredient 6 and see paragraph 259-260 for ingredient 5 and see paragraphs 277-282 for application of the compositions to keratin material.

PGPUB ('929) teaches cosmetic compositions comprising ingredient 1, 2 and 4-6. see the title, see the abstract, see paragraphs 12-26 for ingredient 1, see paragraphs 27-36 for ingredient 4, see paragraphs 37-104 for the cationic polymer and see paragraph 105 for the elected species belonging to cationic polymer, which is ingredient 2, see paragraphs 165-238 for ingredient 6 and see paragraph 239 for ingredient 5 and see paragraphs 257-259 for application of the compositions to keratin material.

The above PGPUB documents do not teach ingredient 3 which is calcium carbonate particles.

However, PGPUB ('356) teaches cosmetic compositions comprising ingredient 3-6. See the title, see the abstract, see paragraphs 21-30 for ingredient 3, see paragraphs 44-70 for ingredient 4, see paragraphs 71-91 for the cationic polymer, see paragraphs 35-43 for ingredient 6 and see paragraph 99 for ingredient 5 and see paragraphs 104-105 for application of the compositions to keratin material.

PGPUB ('355) also teaches cosmetic compositions comprising ingredient 3 and 5-6. See the title, see the abstract, see paragraphs 22-31 for ingredient 3, see paragraphs 44-70 for ingredient 4, see paragraphs 61-80 for the cationic polymer, see paragraphs 35-60 for ingredient 6 and see paragraph 88, 90 for ingredient 5 and see paragraphs 93-94 for application of the compositions to keratin material.

Accordingly it would be obvious to one of ordinary skill in the cosmetic art to prepare another cosmetic compositions by combining the ingredients 1-2 and 4-6 of U. S. Patent 7,258,852 ('852) or US 2003/0108503('503) or US 2003/0103927('927) or US 2004/0001796('796) or US 2003/0103929('929) and combine it with calcium carbonate particles taught by US 2004/0197356('356) or US 2004/0197355('355) in analogous cosmetic compositions. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art.

***Response to Arguments***

Applicant's arguments filed 3/31/08 have been fully considered but they are not persuasive.

Applicants' submit common ownership statement. See below for the statement.

"Applicants herein certify that the '852 patent, the '503 publication, the '927 publication, the '796 publication, and the '929 publication were commonly assigned to L'Or6al S.A. at the time of invention of the present application. The present application is assigned to L'Or6al S.A., as recorded on July 28, 2004 at Reel 015625, Frame 0721. The '852 patent is assigned to L'Or6al S.A., as record on December 10, 2002, at Reel 013567, Frame 0428. The '503 publication is assigned to L'Or6al S.A., as recorded on December 9, 2002, at Reel 013556, Frame 0790. The '927 publication is assigned to L'Or6al S.A., as recorded on December 10, 2002, at Reel 013567, Frame 0430. The '796 publication is assigned to L'Or6al S.A., as recorded on December 10, 2002, at Reel 013568, Frame 0452. Finally, the '929 publication is assigned to L'Or6al S.A., as recorded on December 9, 2002, at Reel 013620, Frame 0096".

This statement is unpersuasive.

MPEP 706.02 (l) (2) under II states that statement can be:

1. "The application and the reference were at the time the invention was made by subject to an obligation of assignment to the same person ".

OR

2. " Application X and patent A were, at the time the invention of Application X was made owned by company Z".

The statement "was made" is missing, therefore this rejection is maintained.

Claims 1, 2, 4-5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 are rejected under 35 U.S.C. 103(a) as being obvious over the combination of U. S. Patents 6,635,702 ('702) and 5,580,494 ('494) and WO documents WO /2002/096,385 ('385) and WO /2002/096,377 ('377) WO /2002/096,377 ('377) corresponds to US 2004/0197355('355) and WO /2002/096,385 ('385) corresponds to US 2004/0197356('356). Examiner is relying on the PGPUB documents for teaching of particles claimed.

*The instant application is claiming a cosmetic composition comprising:*

- 1. At least one cross-linked copolymer comprising at least one methacrylic acid unit and at least one C1-C4 alkyl acrylate unit,*
- 2. Polyethyleneimine, and*
- 3. Particles comprising at least 10% by weight of calcium carbonate*
- 4. Silicone (claims 57, 60 and 62)*
- 5. One agent beneficial to keratin material (claims 61 and 64)*
- 6. Surfactant (claim 66)*

Patent '702 teaches aqueous surfactant compositions using the ingredients 1, and 4-6. Patent '702 teaches ingredient 1 as a rheology modifier. See the abstract for ingredient 1 and silicone. See col.3, lines 20 *et seq* and see col.4, col.5, lines 1-40 for the cross-linked polymer which is formed from the two monomers and the cross linking agent. Patent '702 also teaches surfactants at col.5, line 41 to col.6, line 60 and teaches silicones at col.7, ll 25-68. Patent at paragraph bridging col.s 8-9 suggests adding insoluble compounds and this includes claimed

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calcium carbonate at col.8, line 60. See col.11, ll 50-53 for the additives and these belong to agent beneficial to keratin material like waxes. Patent at col.11, line 41 suggests adding cationic conditioning polymers. This is same as claimed cationic polymer. Patent also teaches the use of these compounds in the compositions in the form of shampoos at col.11, last paragraph. See all the examples. Patent '702 teaches under examples shampoos. Shampoos are for treating keratin material. The difference between the patent and the instant application is the patent does not teach claimed cationic polymer polyethyleneimine or at least 10 % by weight of calcium carbonate. Patent '494 teaches shampoo compositions using the claimed cationic polymer (polyethyleneimine) along with surfactant. See the abstract, see col.2, ll 20-60 for the cationic polymer and see ll 61-62 for polyethyleneimine and see silicones at col.5, ll 5-45. Patent at col.6, ll 51-62 suggests adding thickeners also known as rheology modifiers to the compositions. See examples. WO documents teach using 10 % of calcium carbonate in cosmetic compositions and using these compositions for hair. WO /2002/096,377 ('377) corresponds to US 2004/0197355('355). PGPUB ('355) also teaches cosmetic compositions comprising ingredient 3 and 5-6. See the title, see the abstract, see paragraphs 22-31 for ingredient 3, see paragraphs 44-70 for ingredient 4, see paragraphs 61-80 for the cationic polymer, see paragraphs 35-60 for ingredient 6 and see paragraph 88, 90 for ingredient 5 and see paragraphs 93-94 for application of the compositions to keratin material. WO /2002/096,385 ('385) corresponds to US 2004/0197356('356). PGPUB ('356) teaches cosmetic compositions comprising ingredient 3-6. See the title, see the abstract, see paragraphs 21-30 for ingredient 3, see paragraphs 44-70 for ingredient 4, see paragraphs 71-91 for the cationic polymer, see paragraphs 35-43 for ingredient

6 and see paragraph 99 for ingredient 5 and see paragraphs 104-105 for application of the compositions to keratin material.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '702 and add calcium carbonate and polyethylenimine (cationic polymer) expecting beneficial effect to the hair. One of ordinary skill in the art would be motivated to add the cationic polymer and panthenol into the compositions of '702 expecting that the compositions which has the acrylic acid/alkylacrylate polymer provides acceptable rheology without significant increased or decrease in viscosity or pH, with no separation settling with extended periods of time and adding the polyethylenimine into the compositions provide the a conditioning effects which is excellent for the keratin and adding calcium carbonate particles would provide the additional benefit of better hair style hold and increased sensation of thickness to the hair. This is *prima facie* case of obviousness.

#### *Response to Arguments*

Applicant's arguments filed 3/31/08 have been fully considered but they are not persuasive.

Applicants's argue:

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I) (8th ed. Sept. 2007 Rev.) (emphasis in original) (citations omitted). The '702 patent only broadly discloses, in a laundry list of possible ingredients, cationic polymers which "can optionally be utilized."

The '702 patent at col. 11, lines 36-53 (emphasis added). Additionally, insoluble calcium carbonate is just one of many ingredients listed under "other insoluble compounds." Id. at col. 8, lines 54-67.

The '702 patent provides no direction as to why or how one skilled in the art would selectively choose cationic polymers or calcium carbonate over other ingredients. Further, an examiner must "[c]onsider any teachings of a 'typical,' 'preferred,' or 'optimum' species or subgenus within the disclosed genus."

M.P.E.P. § 2144.08. That analysis necessarily includes those exemplified compositions that are dissimilar from those presently claimed: "[s]uch a teaching may weigh against selecting the claimed species or subgenus and thus against a determination of obviousness." M.P.E.P. § 2144.08 (citing Baird 16 F.3d 380, 382 (Fed. Cir. 1994)). In this case, none of the seventeen Examples in the '702 patent contain at least one water-insoluble solid mineral particle chosen from clays, particles comprising alumina, particles comprising at least 10% by weight of calcium carbonate, and selenium sulphide, as required by the present claims. Further, the Examiner has provided no reason "to select the claimed species or subgenus from the disclosed prior art genus" in the '702 patent. M.P.E.P. § 2144.08.

Further, one would not attempt to simply modify an optional cationic polymer or the amount of an optional insoluble compound listed in the '702 patent with specific groups taught in the '494 patent, WO '385, and WO '377, as suggested by the Examiner".

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In response to the above argument, patent '702 at col.7, ll 15-25 teaches:

Insoluble Materials or Compounds

The materials or compounds which require stabilization can be soluble or insoluble in water. Such compounds include insoluble silicones, silicone gums, volatile and non-volatile silicone oils, pearlescent materials, and other types of compounds set forth hereinbelow.

Patent at col.8, line 60 suggests adding calcium carbonate. The expression "optional"

means that the calcium carbonate can be present or calcium carbonate can be absent. The

purpose of adding calcium carbonate is to provide stabilization. Patent at col.9, ll 3-9 teaches:

The amount of the various insoluble compounds requiring stabilization will vary depending upon its purpose, desired end result, and efficacy thereof. Hence amounts can vary widely, but frequently will be within a general range of from about 0.1% to about 50% by weight based upon the total weight of the stable composition.

Patent at col.11, ll 41-45 suggests adding cationic conditioning polymers. The function of cationic conditioning polymers is to provide conditioning benefit to the substrate, which can be any keratin containing substance. This knowledge is available to one of ordinary skill in the cosmetic art. The expression "optional" means the cationic conditioning polymer is present or the cationic conditioning polymer is absent. Patent does not disclose the claimed species, but substituting one cationic conditioning polymer for another cationic conditioning polymer is obvious since simple substitution of one equivalent to another would yield predictable results.

Therefore one of ordinary skill in the art would be motivated to add the cationic polymer and into the compositions of '702 expecting that the compositions which has the acrylic acid/alkylacrylate polymer provides acceptable rheology without significant increased or

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decrease in viscosity or pH, with no separation settling with extended periods of time and adding the polyethylenimine (cationic conditioning polymer) into the compositions provide conditioning effects which is excellent for the keratin and adding calcium carbonate particles would provide the additional benefit of better hair style hold and increased sensation of thickness to the hair.

This application contains claims 80-84 drawn to an invention nonelected with traverse in the reply filed on 10/29/07. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1615